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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/821,389

04/09/2004

Terrance P. Snutch

381092000624

1599

25225 7590 08/03/2009  
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12531 HIGH BLUFF DRIVE  
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SAN DIEGO, CA 92130-2040

EXAMINER

PACKARD, BENJAMIN J

ART UNIT

PAPER NUMBER

1612

MAIL DATE

DELIVERY MODE

08/03/2009

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/821,389	<b>Applicant(s)</b> SNUTCH ET AL.	
	<b>Examiner</b> Benjamin Packard	<b>Art Unit</b> 1612	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 07 April 2009.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-5,7,9-16 and 19-31 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 16,29 and 31 is/are allowed.
- 6) ☒ Claim(s) 1-5,7,10-14,19-27,30 and 31 is/are rejected.
- 7) ☒ Claim(s) 15 and 28 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>1pg (1/15/09), 1pg(5/20/09)</u> . | 6) <input type="checkbox"/> Other: _____  |



**Claims 19-27 and 30-31** are rejected under 35 U.S.C. 102(b) as being anticipated by Registry STN RN 85816-08-6 (entered into STN 16 Nov 1984).

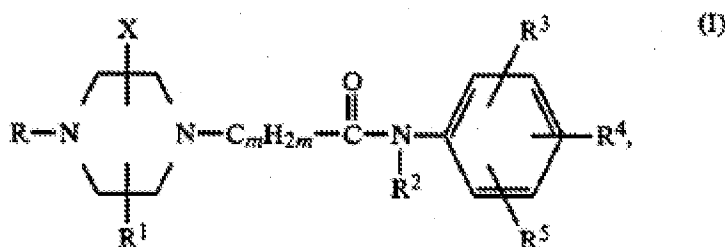
The compound labeled RN 85816-08-6 was entered into the STN database 16 Nov 1984 and the entry was made available as of the date of entry.

***Claim Rejections - 35 USC § 103***

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

**Claims 1-5, 7, and 10-14** are rejected under 35 U.S.C. 103(a) as being unpatentable over Van Daele (US 4,766,125).

Van Daele discloses compounds of formula:



(col 1 lines 35-50) and that compounds of this genus are known to be useful as local anesthetics (col 1 lines 20-26). The groups disclosed above are taught at Table 1, pg 11, about 21 compounds down, where R= 4-F-C<sub>6</sub>H<sub>4</sub>)<sub>2</sub>CH-(CH<sub>2</sub>)<sub>3</sub>-, X is 2-CONH<sub>2</sub>, C<sub>m</sub>H<sub>2m</sub> is CH<sub>2</sub>, R<sub>2</sub> is H, and aryl is 2,6-C<sub>6</sub>H<sub>3</sub>. While is specifically disclosed above, generically, it may be -Alk-Q, where alk is a lower alkyl radical and Q is halo substituted diaryl and lower alkyl is a chain from 1 to 6 carbons (col 2 lines 50-53).

The compound differs from the instantly searched compound in that the linker of R is not at least 5 members long.

It would be obvious to increase the number of linking methyl groups of the disclosed functional group (4-F-C<sub>6</sub>H<sub>4</sub>)<sub>2</sub>CH-(CH<sub>2</sub>)<sub>3</sub>- to -CH<sub>2</sub>)<sub>6</sub>-, given the resulting functional group is a homologue of the instantly claimed functional group and the prior art teaches the linking methyl groups include alkyls having from 2 to 6 carbons. One of ordinary skill in the art would have a reasonable expectation that such a modification would still provide anesthetic properties, given the genus is taught to be useful as local anesthetics.

#### ***Allowable Subject Matter***

**Claims 15 and 28** are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

**Claims 16, 29, and 31** are allowable.

The closest prior art, Van Daele (US 4,766,125) discussed above, and Laigle (EP 0458387) discussed in the Office Action dated 01/07/2009, do not teach Ar may be a single ring heteroaryl group, such as instantly claimed. Additionally, the specific embodiments of instant claims 16 and 29 do not appear to be in the prior art. Where the specific embodiments of instant claim 29 are not disclosed, a pharmaceutical composition comprising them likewise would not be disclosed in the prior art, as claimed in instant claim 31.

***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Benjamin Packard whose telephone number is 571-270-3440. The examiner can normally be reached on M-F 8-5 EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Frederick Krass can be reached on 571-272-0580. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 1612

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Benjamin Packard/  
Examiner, Art Unit 1612

/Frederick Krass/  
Supervisory Patent Examiner, Art Unit 1612